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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/609,073
Filing Date: June 30, 2000
Appellant(s): MARSHALL ET AL.

MAILED

AUG 22 2007

Group 3700

James Leiz
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/25/2007 appealing from the Office action
mailed 1/29/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

- Appellant has stated that claims 2-9, 11-19, and 38-48 are rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Patent No. 5,830,068 Brenner (see pages 4-5 of the Brief). In a footnote on page 4 of the Brief, Appellant acknowledges that the rejection listed in the Office Action mailed 1/29/2007 was actually under 35 U.S.C. 102(e) but, for reasons unknown, believes that the rejection should have been made under 102(a). The

Examiner submits that the rejection under 102(e) is correct and it constitutes the prior art grounds of rejection to be reviewed on appeal for claims 2-9, 11-19, and 38-48.

- A rejection was made under 35 U.S.C. 112, first paragraph regarding the scope of enablement for claims 11, 14, 15, 38, 43, and 44 (and claims 13 and 39-42 which depend therefrom). In light of Appellants' persuasive explanations on pages 15-17 of the Brief, the rejection under 35 U.S.C. 112, first paragraph is hereby withdrawn. Note: the rejection is omitted from section (9) below since it is no longer relevant.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct. Note that the claims are contained in section (viii) of the Appeal Brief (also called Claims Appendix A).

(8) Evidence Relied Upon

5,830,068	Brenner et al.	11-1998
6,004,211	Brenner et al.	12-1999

Sanna, Paul et al. "Special Edition Using Windows NT Workstation 4.0", Que Corporation, 1997, Accessed via ProQuest on 17 Aug. 2007, pp. 1-14, submitted with author and copyright pages.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Interpretation

Claim 19 is directed in pertinent part toward 1) allowing a user to create and place a wager for a given race; 2) automatically providing the user with an opportunity to record the given race in response to the user placing the wager for the given race; and 3) recording the given race. The term "opportunity" is defined as a situation or condition favorable for attainment of a goal (Random House Unabridged Dictionary). Therefore, automatically providing an opportunity to record a race in response to placing a wager, as stated in (2) above, is interpreted as automatically (*without additional effort*) providing an opportunity (*favorable situation or condition*) to record a race in response to (*after*) placing a wager. An analogous interpretation is applied to claim 48. As described below, such features are anticipated by the prior art.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 2-7, 11-19, 38, and 39-48 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5, 17, 37-41, 46 and 49 of U.S. Patent No. 6,004,211 to Brenner et al. (hereinafter Brenner '211).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of Brenner '211 fully encompass the instant claims, as shown in view of the interpretation set forth above.

Claim 39 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 37 of Brenner '211. Brenner '211 teaches a user terminal configured to perform the functions necessary for operation (e.g. the user terminal contains the "control circuitry" as described in instant claim 39). Brenner '211 lacks describing that the user terminal is a set-top box. A set-top box, as described in the context of the claims, is merely a device dimensioned to be capable of sitting on top of a monitor. Such a limitation changes the size of the device, but does not affect the way in which the device operates. As such, instant claim 39 is not patentably from claim 37 of Brenner '211. See *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984). (The

Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.) Therefore, it would have been an obvious matter of choice, well within the capabilities of one of ordinary skill in the art at the time of invention to embody the control circuitry of Brenner '211 in a set-top box in order to minimize the size of the device so as to allow the device to sit atop a monitor (the monitor being required by Brenner '211 to operate).

Claims 8-10 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4, and 5 of Brenner '211. Claims 1, 4, and 5 of Brenner '211 allow, in pertinent part, a user to select and view video clips of particular races using a user terminal. Brenner '211 lacks in describing that the recorded races are listed with corresponding track names, race numbers, or dates. However, it is clear from the claims of Brenner '211 that a user must be able to discern an individual race from a plurality of previously recorded races and input a request to view said race. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to list recorded races with their corresponding track names, race numbers, and/or dates in order to allow a user of the system to identify and select a particular race as is required by the claimed system of Brenner '211.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 2-9, 11-19, and 38-48 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. 5,830,068 to Brenner et al. (hereinafter Brenner '068).

Regarding claims 19 and 48, Brenner '068 teaches a method and system for a user at user equipment to interactively wager on races with an interactive wagering application implemented using the user equipment (see at least abstract, figs. 1, 2, 29, 30, and cols. 2-5). Brenner '068 further teaches a system and method step of allowing the user to create and place a wager for a given race (see at least abstract, figs. 3-7, 15, 31-34, 36-44, 46, 48-50, and cols. 2-5). Brenner '068 additionally teaches a system and method step of recording the given race (see at least figs. 30, 34, 49 and cols. 3:11-14, 4:65-5:3, and 27:65-28:15).

Further regarding claims 19 and 48, Brenner '068 teaches a system and method step of automatically providing the user with an opportunity to record the wagered upon race in response to the user placing the wager for the given race. Figure 31 shows a

flow chart for placing a wager on a particular race, with figures 36-39 showing user interfaces for placing the wager. Box 486 of figure 31 shows the "Place Wager" selection, which instructs the system to Place Wager operation 510, and then returns to box 486. Therefore, Brenner '068 teaches a system and method step of allowing a user to create a wager for a given race. Box 486 is represented by the user interface of figure 39. The flow charts of figures 31, 32, and 34 (explained in cols. 23-28) and the user interfaces of figures 48-49 show that in response to placing the wager, the user *automatically* has the *opportunity* to record the wagered upon race by selecting menu choices "Other Race" and "Tape/VCR" to program a video recorder to record the race (see at least cols. 27:65-28:15). Therefore, in Brenner '068 the opportunity to record the race is provided automatically and in response to placing a wager.

Regarding claims 2 and 3, Brenner '068 states, "If 'tape/VCR' is selected at step 596 (FIG. 34), at step 606 (FIG. 34) user terminal 370 (FIG. 30) programs video recorder 424 (FIG. 30) with the appropriate recording information or actuates video recorder 424 (FIG. 30) at the time of the selected race. Thus, selecting 'tape/VCR' allows the selected race to be recorded" (col. 28:5-11). Therefore, selecting "yes" is anticipated by a user of Brenner '068 pressing "Tape/VCR" to actuate recording, whereas selecting "no" is anticipated by a user of Brenner '068 pressing any other button and/or not pressing "Tape/VCR".

Regarding claims 11, 38, and 40, Brenner '068 teaches that the user equipment is user television equipment, for example in the form of a "conventional television monitor" (col. 3:59-60).

Regarding claims 12 and 41, Brenner '068 teaches that a recording device may be a "conventional video cassette recorder" (col. 21:56-58).

Regarding claims 13 and 42, Brenner '068 teaches recording a given race with a digital video recorder indicated by the digitally-compressed video signals being processed, encoded, decoded, and transmitted by the video and data distribution system 368 and/or the user terminal 370 (see at least 27:46-64). The digital video recorder is further indicated by the recitation of a high capacity storage medium, suitable for recording races as they are received from racing video source 374, embodied in video and data distribution system 368 (see at least 27:39-45).

Regarding claims 14 and 43, Brenner '068 describes employing user computer equipment in the form of user terminal 122, which is described as being "preferably microprocessor-based [and] supports software capable of coordinating the receipt and display of racing data and the placing of wagers electronically" (col. 7:21-24). See also fig. 1 and col. 7:24-34.

Regarding claims 15 and 44, Brenner '068 teaches that user equipment is telephone equipment used to implement the interactive wagering application (see at least 7:35-54, 8:29-40).

Regarding claim 16, Brenner '068 teaches recording a race in real-time (see at least col. 6:55-62 and 17:65-18:40).

Regarding claims 17 and 47, Brenner '068 describes recording the race after it has taken place (see at least cols. 26:65-27:22).

Regarding claim 18, Brenner '068 teaches charging a fee for recording a given race (see at least col. 27:33-39).

Regarding claim 39, Brenner '068 discloses using a set-top box 434 disposed between display and processing circuitry 416 and monitor 378 (see at least fig. 30 and 22:13-15). Therefore, Brenner '068 teaches a set-top box wherein control circuitry is located, wherein the control circuitry is configured to allow the user to create and place a wager for a given race.

Regarding claims 6 and 45, Brenner '068 teaches a recording device located remote from the user equipment (see at least 7:4-20, 17:48-18:14, 21:63-22:12, and 27:23-29).

Regarding claims 4, 5, 7, and 46, as described above, Brenner '068 teaches recording racing videos on a videocassette, which is interpreted as a personal archive. Further support for the interpretation is found in above-cited sections of Brenner '068 regarding the user's own home equipment (e.g. the video cassette recorder), which is personal equipment and personal recording media (e.g. the video cassette). Brenner '068 further describes using the interactive wagering application to allow the user to access the personal archive at the head end or at the user equipment and view previously recorded races in cols. 7:4-20, 17:48-18:14, 21:63-22:12, and 27:23-29. See also local mass storage device 578 (FIG. 3).

Regarding claims 8-9, Brenner '068 teaches listing previously recorded races in the personal archive with their corresponding track name and race number (see at least figs. 49-50 and descriptions thereof).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brenner '068. Brenner '068 teaches the interactive wagering system substantially as described above. Brenner '068 lacks in specifically disclosing that previously recorded races in the personal archive are listed with their corresponding date. As described in Brenner '068, players place wagers on specific races, which requires that the player be able to correctly identify the results of a given race, for example in order to select from a list a previously recorded race upon which a player has placed a wager. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide date information with previously recorded races in order to allow users to correctly identify when the race took place. See at least figs. 49-50 and descriptions thereof.

(10) Response to Argument

Section A

Beginning on page five, Appellants argue that 'reopening prosecution is improper and unduly delays the issuance of the patent'. The Examiner notes that this is not an appealable issue and the argument is therefore moot. However, because Appellants seem to be confused about the grounds of rejection applied to their claims, the Examiner will briefly reply. The grounds of rejection stated in section (9) above are, in

fact, the grounds of rejection that should be considered on appeal. Any previous grounds of rejection in previous Office Actions are or were withdrawn. Appellants need not refer to grounds of rejection other than those listed hereinabove.

In their confusion, Appellants attempted to provide a copy of the Appeal Brief dated July 19, 2006 in Evidence Appendix C. The Examiner notes that no additional copy of the July 19 Appeal Brief appears to have been submitted. However, it should make no difference to this Appeal Brief, since the July 19 Appeal Brief addressed rejections that have been withdrawn.

The (current) Appeal Brief states on page 6, "Appellants want to exercise their statutory right to have their application reviewed by the Board without any further undue delay." The Examiner is unaware of any statute that bars the Examiner from reopening prosecution on an application when new grounds of rejection are applied and supervisory approval to reopen prosecution is obtained. In any case, this is not an appealable issue and the argument is moot.

On page 7 of the Brief, Appellants state that the Examiner believes that the previous 103 (a) rejection is still a proper rejection of the claims. This is incorrect. As stated above, all rejections prior to reopening prosecution were withdrawn and replaced by those listed in the Office Action mailed 1/29/2007 or as listed above.

Section B

Appellants attempt to traverse the prior art rejection of Brenner '068. Note that the rejection is made under 102(e) and not 102(a), as was described hereinabove.

In subsection (i) Appellants describe their central argument (see pages 7-10 of the Brief). Appellants essentially argue that automatically providing a user with an opportunity to record a given race in response to placing a wager on the given race is a patentable difference over the cited prior art. The Examiner respectfully disagrees.

The Examiner submits that given the broadest reasonable interpretation of the claimed subject matter, Brenner '068 anticipates Appellants' independent claims. For example, claims 19 and 48 are directed in pertinent part toward allowing a user to create and place a wager for a given race, automatically providing the user with an opportunity to record the given race in response to the user placing the wager for the given race, and recording the given race. As was explained in the Office Action dated 1/29/2007, the term opportunity is interpreted as "a situation or condition favorable for attainment of a goal," in accordance with the definition from a common language dictionary (see *Claim Interpretation* above). Appellants have never challenged this dictionary definition and the Examiner submits that it is proper regardless.

Claims 19 and 48 do not state that the given race upon which a wager is made is automatically recorded, but rather claims 19 and 48 state that there is an opportunity to record the race and the opportunity is automatic. Therefore, when the claim language is directed toward automatically providing an opportunity to record a race in response to placing a wager, as recited in the independent claims, it is interpreted by the Examiner as automatically (*without additional effort*) providing an opportunity (*favorable situation or condition*) to record a race in response to (*after*) placing a wager. As described in the grounds of rejection, such features are anticipated by the prior art.

As pointed out by the Examiner and repeated by Appellants on e.g., pages 8-9, Brenner '068 teaches that a user of his system is permitted to select the menu options in order to instruct the device to record a race. Detailed citations of Brenner '068 are given above in the grounds of rejection and will not be repeated herein. Essentially, Appellants are arguing that because the user must push a few buttons (e.g., the player selecting "Other Races" or "Tape/VCR") in between placing his wager and choosing to record the given race, Brenner '068 fails to automatically provide an opportunity to record the race. This simply is not true. Clearly the user is given the opportunity to select to record the wagered-upon race, despite the fact that he must push buttons in order to do it. The claims do not say that the race is automatically recorded in response to the wager being place, but rather that there is an opportunity to record the race, the opportunity being automatic. The conditions for a player to record the race, or opportunity to record the race, are present in response to placing the bet and are automatic. Therefore, Brenner '068 clearly anticipates the independent claims.

In subsection (ii) Appellants attempt to show patentability of dependent claim 2 (see pages 10-11 of the Brief). The Examiner submits that nowhere in claim 2 is there any indication that the words "yes" or "no" are displayed on a screen of the claimed invention, contrary to Appellants' apparent assertion. The Examiner interprets the claim 2 as allowing the user of Appellants' system to enter a command into the system to accept or decline the option of recording the given race. When one considers the teachings of Brenner '068 and what a player must do in order to record a race (as detailed in the grounds of rejection above), it is clear that the player has the option to

either record the given race or not record the given race. Therefore, the rejection of claim 2 should be sustained. The Examiner notes that even if there were some indication that "yes" or "no" are displayed to the player (which is clearly not the case), there is absolutely no criticality to using this exact verbiage. Clearly one could just as easily use synonyms of "yes" or "no" to produce exactly the same results, meaning that even if Appellants correctly characterized claim 2 (which they have not), claim 2 would still fail to show a patentable difference over the cited prior art.

In subsection (iii) Appellants attempt to show patentability of dependent claim 8 (see pages 11-12 of the Brief). Appellants argue that Brenner '068 does not teach listing previously recorded races in the personal archive with their corresponding track name and race number, rebuffing the Examiner's reference to figures 49 and 50 (and corresponding disclosure) of Brenner '068. The Examiner submits that even a cursory review of figures 49 and 50 show previously recorded races with their corresponding track name and race number. For example, Races 1-4 are shown under the heading "Select Race". These are examples of "race numbers" as recited in claim 8, wherein races 1 and 2 are previously recorded as evidenced by the fact that the player may choose to see the outcome of those races. Furthermore, the track name "Hollywood Park" is shown by figure 49 in the top left hand corner. Similarly, figure 50 shows "Hollywood Park" track name and "Race 1" race number, and additionally presents the user the option of watching the race.

Appellants appear to believe that the above features do not refer to a "personal archive" because the above figures "enable users to set a recording or order a video of

a race" (page 12 of the Brief). The Examiner submits that figures 49-50 and their respective features clearly show a personal archive at least because they allow the user to 1) set his own recording of an upcoming race or 2) allow the user to make a personal, individual order to view a previous race on demand. This is in contrast to e.g., watching conventional television programming over which the user has no control. Therefore, the rejection of claim 8 should be sustained.

Section C

Beginning on page 12 of the Brief, Appellants challenge the rejection of claim 10 under 35 U.S.C. 103(a). As described in the grounds of rejection above, Brenner '068 teaches that players place wagers on specific races, which requires that the player be able to correctly identify the results of a specific race. Further taught by Brenner '068 is the fact that players select from a list of previously recorded races for the purpose of viewing those races. Those race videos may portray the results of one or more races upon which a player has placed a wager, which demonstrates a clear benefit to displaying to the user the date on which a race took place. It is clear that the device of Brenner '068 is capable of and intended for use over more than a single day. Therefore, because a user of Brenner '068 must be able to identify the individual races, potentially over a plurality of days, there is clearly a need to display the date on which races took place. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide date information with previously recorded races in order to allow users to correctly identify when the race took place. The rejection of claim 10 under 35 U.S.C. 103(a) should be sustained for at least these reasons.

It should be noted that Brenner '068 demonstrates displaying date and time information in figure 8, element 178. This serves as further proof that Brenner '068 contemplates associating and displaying date and time information in relation to betting on and viewing races.

Additionally, because the video of Brenner '068 may be stored in digital format, it is inherent that the date of a recording is stored in association with the digital data (see e.g., col. 27, lines 39-45). The Examiner submits that virtually every modern computer operating system appends a date to digital files representing the date that the file was created. As an illustrative example, Windows NT employed a file system that identified the date and time that each file was created (see page 9 of *Special Edition Using Windows NT Workstation 4.0*). The figure on page 9 demonstrates that a file's creation date is available to the user at the click of the mouse. This is yet another exemplary showing that recording and displaying to a user, the date of a race video (or any other file type) was well within the capabilities of one of ordinary skill in the art at the time of Appellants' invention. Appellants' claim 10 is nothing more than a combination of prior art elements according to known methods to yield predictable results. For at least these reasons, rejection of claim 10 under 35 U.S.C. 103(a) should be sustained.

Finally, claim 10 was also rejected over Brenner '211 based upon non-statutory obviousness type double patenting (see Grounds of Rejection above and Section D below). The double patenting rejection is based on similar logic to that of the 103 rejection detailed above. Specifically, the Examiner stated that it is clear from the claims of Brenner '211 that a user must be able to discern an individual race from a

plurality of previously recorded races and input a request to view said race. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to list recorded races with their corresponding track names, race numbers, and/or dates in order to allow a user of the system to identify and select a particular race as is required by the claimed system of Brenner '211. Appellants' have made no argument challenging the specific logic behind the obviousness-type double patenting rejection. Since this logic is substantially similar to that of the 103 rejection, the Examiner submits that the rejection of claim 10 under 35 U.S.C. 103(a) should be sustained.

Section D

Beginning on page 13 of the Brief, Appellants challenge the double patenting rejection of claims 2-19 and 38-48 over Brenner '211. As an initial matter, it should be noted that Brenner '211 is a continuation of Brenner '068, meaning that each of the Brenner patents share the same specification. Therefore, the Examiner respectfully submits that if the obviousness-type double patenting rejection over Brenner '211 (and teachings from other prior art) is sustained, then the prior art rejection of Brenner '068 (and the teachings from the same prior art) above must also be sustained because the claims of Brenner '211 are enabled by the same specification as Brenner '068.

On page 13 of the Brief, Appellants accuse the Examiner of ignoring the citations in case law proffered by Appellants in previous communications with the Office. Those citations allegedly dictate that obviousness-type double patenting (ODP) rejections should be used for references that are not available as prior art under 35 U.S.C. 102 or 103. The Examiner respectfully disagrees. The purpose of an ODP rejection is to

prevent improper or unjustified timewise extension of the right to exclude. MPEP 804 states the following:

A rejection based on nonstatutory double patenting is based on a judicially created doctrine grounded in public policy so as to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent. *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re White*, 405 F.2d 904, 160 USPQ 417 (CCPA 1969); *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968); *In re Sarett*, 327 F.2d 1005, 140 USPQ 474 (CCPA 1964).

The Examiner has pointed to Chart II-B listed in MPEP 804.03 to show, in graphical format, that ODP rejections are proper in situations such as this. Appellants have acknowledged the chart, but consistently discount the chart section of the MPEP, calling them "preliminary instances where the Examiner cannot resolve the ownership of the application and the ownership of the reference with conflicting claims" (Brief, page 14). The Examiner respectfully submits that whether the invention shared a common assignee with Brenner '211 at the time of invention is irrelevant because the two are commonly assigned now and an ODP rejection is proper either way. Both situations are shown on the lowest two branches of Chart II-B and both situations allow for an ODP rejection. Therefore, the ODP rejection over Brenner '211 should be sustained.

The Examiner acknowledges that Chart II-B gives a footnote in the situation where inventions are from different inventive entities, commonly owned at the time of invention (second branch from the bottom of the chart). The box representing this situation instructs the Examiner to make an ODP rejection. The footnote instructs the Examiner that where the reference is available as anticipatory prior art, a rejection

should be made under 102(e). The Examiner believes this note is intended to produce the "strongest" grounds of rejection by citing a 102(e) rejection in conjunction with an ODP rejection. However, because Brenner '068 is the parent of Brenner '211, it is appropriate to use Brenner '068 for the 102(e) rejection (see above) instead of Brenner '211. An additional 102(e) rejection over Brenner '211, while technically proper, would be redundant since there is already a 102(e) rejection using Brenner '068.

Appellants have repeatedly cited a portion of the MPEP that instructs the Examiner on the manner of making an ODP rejection. That citation states "[a] double patenting rejection of the obviousness-type...is 'analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103' except that the patent principally underlying the double patenting rejection is not considered prior art". See MPEP 804 (B)(1). Appellants base their argument upon the last few words of the citation: "the patent principally underlying the rejection is not considered prior art". The Examiner believes that this refers to the fact that the underlying patent in a double patenting rejection (in this case, Brenner '211) must be considered in terms of its claims alone, as opposed to a prior art rejection that may be based upon teachings from anywhere in an underlying patent.

In view of the above arguments, the ODP rejection over Brenner '211 should be sustained.

Section E

Section E refers to a rejection under 35 U.S.C. 112, first paragraph regarding the scope of enablement for claims 11, 14, 15, 38, 43, and 44 (and claims 13 and 39-42

which depend therefrom). In light of Appellants' persuasive explanations on pages 15-17 of the Brief, the rejection under 112 (1) is hereby withdrawn.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained:

Respectfully submitted,

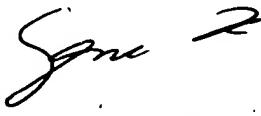
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Along with his work in various industry periodicals, Paul has co-authored four books on Windows 95 and Windows NT: *Understanding Windows 95* (New Riders), *Inside Windows 95 (New Riders)*, *The Windows Installation and Configuration Handbook* (Que), and the first edition of *Special Edition Using Windows NT Workstation 4.0* (Que). Paul has a degree in English from Boston University. Paul lives in Charlotte, NC, with his wife Andrea, and their daughters, Rachel, Alison, and Victoria. He can be reached on the Internet at psanna@ix.netcom.com.

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Kathy Ivens has been a computer consultant since 1984, and has authored and co-authored many books on computer subjects. She is a frequent contributor to national magazines, writing articles and reviewing software. Before becoming an expert in computing, Ms. Ivens spent many years as a television producer, where she had fun producing sports and was mildly amused producing news and entertainment programs. Preceding that career was some professional time spent as a community organizer and also as a political consultant. She still doesn't know what she wants to be when she grows up.

Kevin Jones has worked in the computer industry for 15 years. He has worked from large corporations, IBM and Unisys, down to very small startups. He has worked on such flagship products as dBASE III & IV, PC Tools for Windows, and Norton Navigator. Currently, he is a Principal Software Engineer with the Peter Norton Division of Symantec Corp. He has been actively working with Windows 95 since October of 1993

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Michael Marchuk has been involved with the computing industry for over 17 years. Michael currently manages the development research department for a mid-sized software development firm while consulting for small businesses and writing leading-edge books for Que Publishing. Along with his bachelor's degree in Finance from the University of Illinois, he has received certification as a NetWare CNE and a Compaq Advanced Systems Engineer.

Sue Mosher is an independent Windows consultant and has written on Windows networking, Microsoft Mail, Exchange, and Schedule+ for various newsletters and books. She is well known on the Windows support forums on CompuServe and the Microsoft Network, earning recognition as a Microsoft Most Valuable Professional. Before starting her own business, Slipstick Systems, she was a broadcast journalist and software developer for The Associated Press for 15 years. Her favorite previous job was as a progressive rock disc jockey.

Michael O'Mara is a freelance author and technical writer. Previously, he was a staff author with The Cobb Group where he wrote innumerable articles about leading computer software programs and served as Editor-in-Chief of several monthly software journals. He has coauthored or contributed to other Que books including *Using DOS; Using Windows 3.11; Special Edition Using CompuServe; Special Edition*

Using Windows 95; Special Edition Using Windows NT Workstation 3.51, 10 Minute Guide to Freelance Graphics 96 for Windows 95, and Using Your PC. He can be reached at 76376.3441@compuserve.com.

Sue Plumley has owned and operated her own business for eight years; Humble Opinions provides training, consulting, and network installation, management, and maintenance to banking, education, medical, and industrial facilities. In addition, Sue has authored and co-authored over 50 books for Que Corporation and its sister imprints, including *10 Minute Guide to Lotus Notes*, *Special Edition Using Windows NT Workstation*, and *Easy Windows 95*.

Michael D. Reilly has 24 years of experience in computer data processing, including extensive experience on DEC's VAX series 780/785, SEL's 32/75, the CDC 3600, and Xerox 9300. He has been involved with personal computers since 1984. His background includes programming in Fortran, and developing applications in Microsoft Access, Oracle, and Progress. He has worked on the VMS, UNIX, DOS, Windows, and Windows NT operating systems. Mike has held positions in management, research, software design and development, scientific data processing, computer sales and installation, training and support, and technical writing.

In 1990, he cofounded Mount Vernon Data Systems, Inc., a consulting company that specializes in client/server database applications. He is a Microsoft Certified Trainer for Windows NT, and has co-authored two books on Microsoft Access. Mike has an MA degree in Physics from Queens College, Cambridge University. You can reach him on CompuServe at **72421.1336**.

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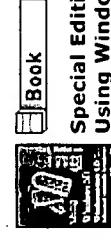
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by Sue Plumley

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Services
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Network at Your
Workstation▶ **Managing Shared
Files**

You can share files and directories over the network with anyone you choose. You might want to share directories, for example, containing files with one of your coworkers or share files with all of your coworkers. Some files you might share include spreadsheet, database, accounting, word processing, and so on. Some directories you might share include file and application directories.

In addition to sharing files and directories over the network, you also can stop sharing files and directories at any time. When you stop sharing a directory or file, it's no longer available over the network.

When you designate a directory as shared, the files within that directory are also shared, unless you set file permissions to limit access to your files. When you're the owner of a file or files, you can enable access of those files to anyone on the network or to no one.

- **Share and stop sharing directories and files**

Before others on the network can access files and directories on your computer, you must designate those files or directories as shared. You also can stop sharing a file or directory on your machine at any time.

- **View shared files**

Resources	Windows NT provides a special icon to represent shared directories and files; you can view shared files on anyone's computer, as long as you have permission.
Sharing Directories and Files	
Setting Access for Directories and Files Usage	<ul style="list-style-type: none"> • Set directory and file permissions
Auditing Resource Usage	After you designate files and directories as shared, you can choose to grant special permissions to individuals or groups.
From Here...	
► Integrating Windows NT in Novell Environments	<ul style="list-style-type: none"> • Audit shared files and directories
► Going Online with Windows NT Workstation	Track access to any files and directories you designate as shared so you know who uses your resources.
► Optimizing and Protecting Windows NT Workstation	
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Sharing Directories and Files	
Browse by Category	You can share directories and the files they contain with others over the network. You can choose with whom you want to share, view shared files, and change sharing properties.
► Applied Sciences	
► Artificial Intelligence	
► Business	
► Certification	<p>Note</p> <p>For the most part, Windows NT uses the terms <i>folder</i> and <i>directories</i> interchangeably; when discussing sharing, Windows NT uses the term <i>directories</i>.</p>
► Computer Science	
► Databases	
► Desktop Publishing	In addition, you can stop sharing directories at any time to prevent others on the network from viewing and using your directories and files.
► Desktop Applications	
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► E-Commerce	
► Enterprise Computing	
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	→ See Working with Groups
	Windows NT automatically designates shared resources—directories, drives, printer, and so on—on a workstation, depending on the configuration of the computer. These shared resources are only for administrators, server operators, or backup operators to connect to and use for purposes of managing the network. Only members of the Administrators group can change the sharing properties on these

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As a user, you can select the resource on your workstation and stop sharing it. However, the next time you log on to your computer, the resource automatically changes back to shared. This is so the administrator can always connect to your computer for management, troubleshooting, backing up, and other system tasks.

Sharing and stopping sharing are controlled in the Windows Explorer. When you indicate you want to share a directory and its files, Windows NT places an open-hand icon beside the directory in the Explorer to indicate it is designated as shared (see Figure 15.1).

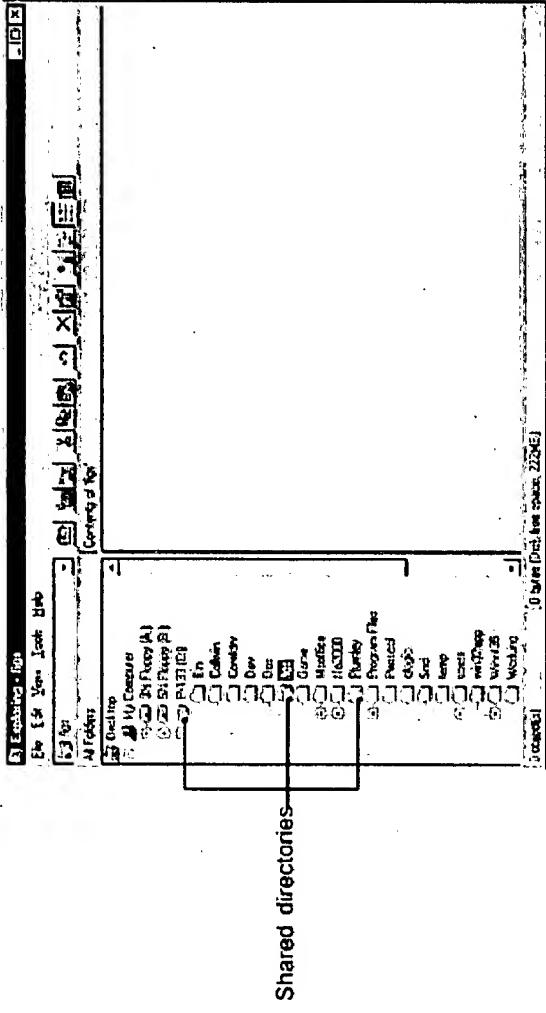
Tip

A dollar sign in the name of the drives and directories, such as ADMIN\$, indicates an administrative shared directory. Only members of the Administrators, Server Operators, or Backup Operators groups can access these directories. The trailing \$ keeps the share hidden from any browse window.

Granting Share Rights

You can designate share rights to any directory on your computer. Remember, however, that all files within the directory are also shared, unless you specify permission rights for individual files. For more information, see the section Setting Access for Directories and Files later in this chapter.

Figure 15.1. Shared directories on the network.

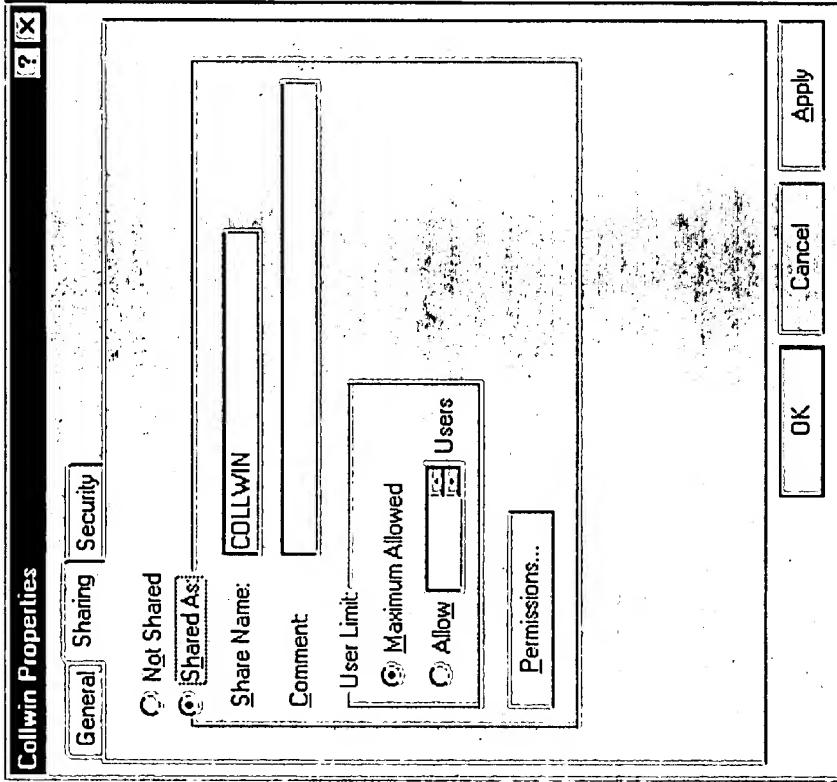
**Note**

You can only designate file-level permissions to files if the file system used on your computer is NTFS (New Technology File System). You cannot specify file-level permissions in a FAT (File Allocation Table) file system.

You indicate shared directories in the Windows Explorer. To open the Explorer and share directories, follow these steps:

1. Choose Start, Programs, Windows NT Explorer to display the Explorer (refer to Figure 15.1).
2. In the directory window (the left window), right-click the directory you want to share to display the shortcut menu.
3. Choose Sharing. The Properties sheet appears; choose the Shared As option (see Figure 15.2).

Figure 15.2. Choose to share a directory and optionally set limits on the share.



4. In the Share Name text box, enter a new name to call the directory if you don't want to use the default name. Windows NT enters the directory name as the Share name by default.

Note

The share name can be up to 12 characters long. If you're using Windows 95 clients over the network, 12 characters are fine. However, if MS-DOS computers also connect to and use your shared directories, the share name must conform to MS-DOS naming conventions: an eight-letter name with an optional three-letter extension.

5. Optionally, add a description or note about the directory in the Comment text box. Other users will see this comment.
6. In the User Limit area of the dialog box, choose one of the following options:
 - o **Maximum Allowed.** Sets no limit to the number of users who can connect to the shared directory at one time.
 - o **Allow.** Set a limit by selecting this option and entering the limit you want in the Users text box.
7. Choose OK to close the dialog box and share the directory.

Tip

You can set permissions for file access by clicking the Permissions button, explained later in this chapter in the section "Setting Access for Directories and Files."

troubleshooting: TROUBLESHOOTING

I'm logged on as a member of the Administrators group but sharing is not available to me. Is there anything I can do? Yes. Before you can share a directory, the Server service must be running. Normally, the service is automatically started; however, if it is not running, you can start the service yourself. To start the Server service, open the Control Panel and open the Services icon. In the Service list, locate Server. In the Status list, make sure the Server is Started. If it is not, select Server and click the Start button. Choose Close to close the Services dialog box.

Viewing Shared Files

You can view any shared files in a shared directory to view file properties, change access attributes, see who has the file open, and to close the file to stop it from being shared.

Viewing shared files consists of two steps: viewing the file's properties and viewing the network properties. Included with the file's properties is general information about the file—file name, path, size, and so on—and file attributes. *File attributes* are controls you can add to a file to limit access by

others.

Included with viewing network properties is general information—file name and path, total number of times the file has been opened, and so on. You also can choose to close the file to sharing in the Network Properties dialog box.

Using File Attributes Set file attributes to control other users' access to your files in a shared directory. On drives formatted to use the Windows NTFS, you need permission to change file attributes. You set file attributes in the file's Properties dialog box.

Table 15.1 describes the file attributes you can set in the file Properties dialog box.

Table 15.1. File Attributes

Attribute	Description
Read-Only	Marks files that can be opened and viewed but not changed in any way; changes cannot be saved to the file but the user could save the file under another name
Archive	Marks files as changed since the last backup to ensure the next backup will be included
Compressed	Compresses files and directories; a file moved to another directory takes on the compression attribute of the new directory
Hidden	Hides files so they do not appear in the directory window
System	Identifies files as system files and hides the system file from the directory window

Viewing File Properties When you view the properties of shared files, the Explorer displays the file type, name, size, path, the DOS name, creation date, the date of the last change to the file, and the last access date. You also can set attributes in the file's Properties dialog box.

To view a shared file's properties, follow these steps:

1. In the Explorer, select the file you want to view.
2. Choose File, Properties. The file's Properties sheet appears (see Figure 15.3). Alternatively, press Alt+Enter on the highlighted file.
3. In the Attributes area, add or remove the attributes you want to use. You will not see the compressed attribute unless your drive has been compressed.

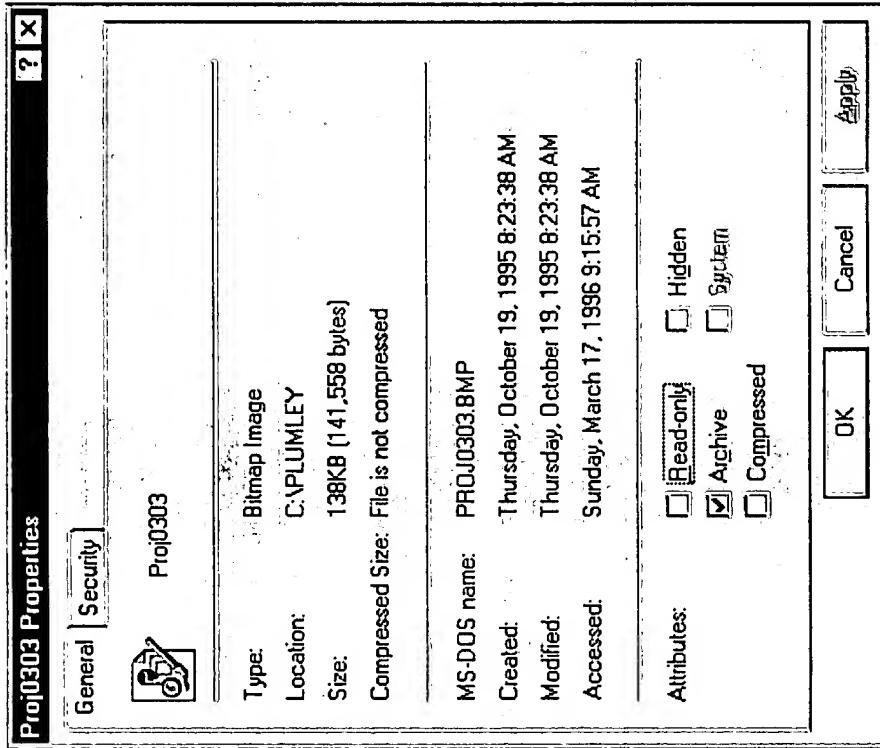
4. Choose OK to close the Properties dialog box.

Next we will look at how to change the properties of a share.

Changing Share Properties

If you're logged on as a member of the Administrators, Server Operators, or Power Users group, you can change share properties of a directory by changing the number of users, comment information, or permissions. You also can view information about the directory and change the attributes on the directory.

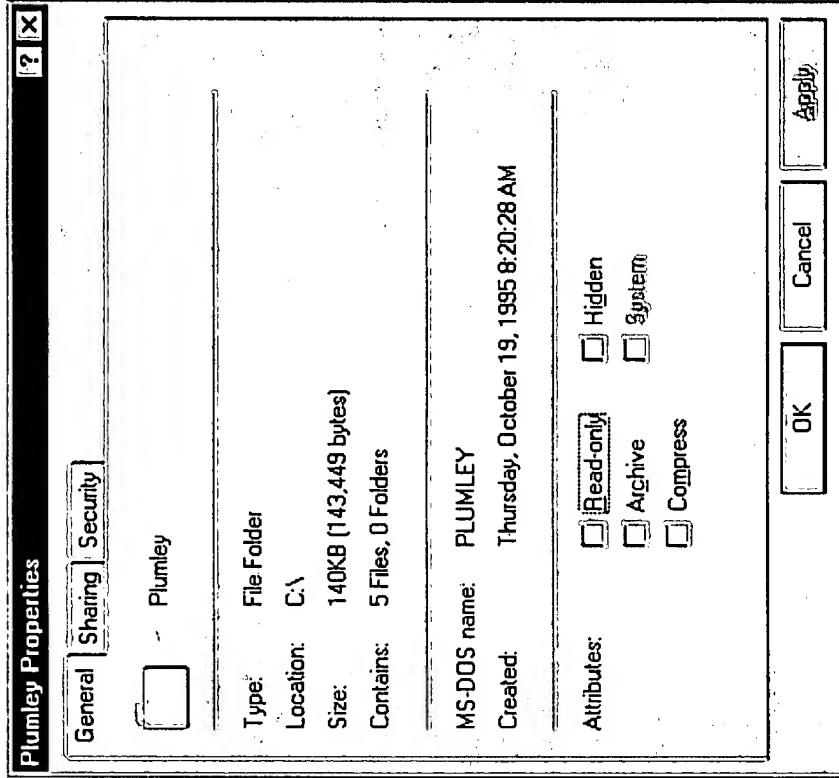
Figure 15.3. View the properties of the selected file and set attributes.



To change share properties, follow these steps:

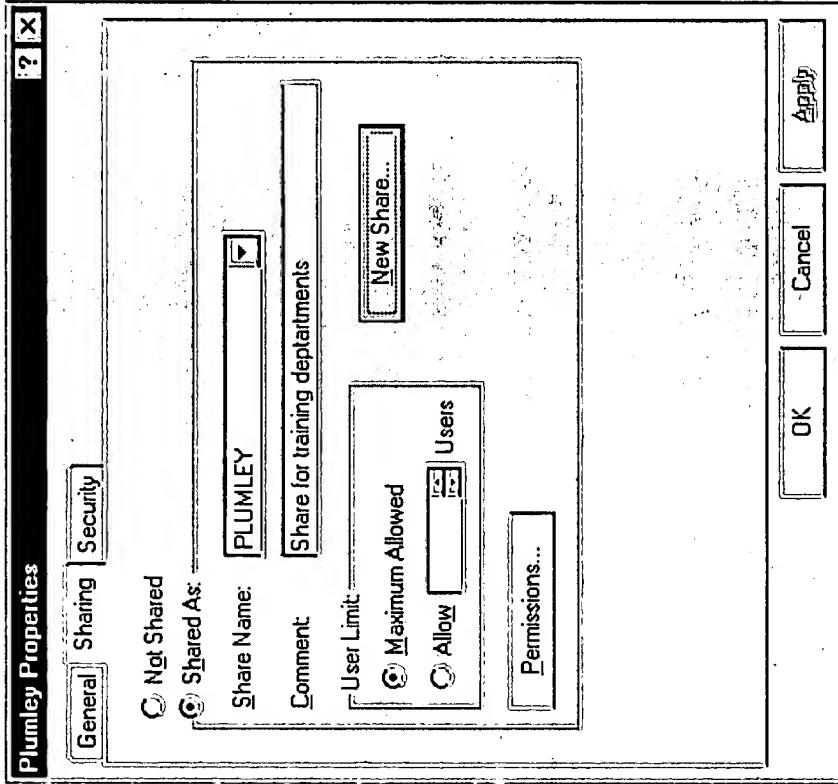
1. In the Explorer, select the directory whose share properties you want to change.
2. Choose File, Properties. The directory's Properties sheet appears (see Figure 15.4). Make any changes you want in the Attributes area of the General tab.

Figure 15.4. View details about the directory and modify the attributes.



3. Choose the Sharing tab (see Figure 15.5).
4. You can modify the following properties of the shared directory:
 - Change the Share Name
 - Change or remove the Comment text
 - Change the User Limit
 - Change Permissions

Figure 15.5. Make changes to the share settings in the Sharing tab



Note

For more directory, see the section Setting Access for Directories and Files later in this chapter.

5. Click New Share to set share properties for another directory. Choose OK when finished to return to the directory's Properties sheet.

6. Choose OK when finished to close the directory's Properties sheet.

You have learned how to share a file, as well as change properties and attributes of a share. Critical, though, to the entire process, is understanding how to stop sharing a file. This topic is covered next.

Stopping Sharing

You can stop sharing directories and the files they contain at any time if you're logged on as a member of the Administrators, Server Operators, or Power Users group.

To stop sharing a directory, follow these steps:

1. In the Explorer, select the drive containing the directories you want to stop sharing.
2. Right-click the directory and choose Sharing from the shortcut menu.
3. In the directory's Properties sheet, choose the Not Shared option.
4. Choose OK to close the Properties sheet.

Caution

If you stop sharing a directory that's in use, the users will lose their data

troubleshooting: TROUBLESHOOTING

I chose to stop sharing the ADMIN\$ and C\$ directories on my computer; I had never chosen to share them. The next time I connected to the network, however, those directories were shared again. Is there any way to get them off of there? No. Any shared directory with a dollar sign in the name is one used for administrative purposes. Only a member of the Administrator group can change attributes on one of these shared directories and only members of the Administrators, Server Operators, or Power Users group can access these directories. If you choose to stop sharing the directories, the network automatically designates them as shared the next time you connect.

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From Microsoft® Windows Server™ 2003 Inside Out by William R. Stanek
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